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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/518,926      | 12/23/2004  | Makoto Ishikawa      | 1422-0655PUS1       | 7260             |

2292 7590 09/16/2008  
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| EXAMINER |
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KUGEL, TIMOTHY J

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1796

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|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

09/16/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/518,926 | <b>Applicant(s)</b><br>ISHIKAWA ET AL. |  |
|                              | <b>Examiner</b><br>Timothy J. Kugel  | <b>Art Unit</b><br>1796                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-4 are pending as amended on 10 July 2008, claims 5-10 being cancelled.
2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.

### ***Response to Amendment and Arguments***

3. Applicant's claim amendment, argument and the declaration under 37 CFR 1.132, filed 10 July 2008, have been entered and fully considered. The declaration filed under 37 CFR 1.132 is identical to that filed 31 January 2008 and has been treated in the Office action mailed 21 February 2008.
4. Applicant's cancellation of claim 6 has rendered the following moot:  
  
The advisory that should claim 4 be found allowable, claim 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof has been withdrawn.
5. Applicant's arguments have been fully considered but are not persuasive.  
  
Applicant argues that the examiner has not established a *prima facie* case of obviousness and that there is presented no rationale beyond impermissible hindsight in view of the instant claims to combine the teachings of US Patent 6,193,986 (Sakurada hereinafter), US Patent 4,379,755 (Yamada hereinafter) and International Patent

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Application Publication WO 01/58279 (Takahashi hereinafter); however it is the examiner's position that a *prima facie* case has been presented and the rationale to combine is found in the prior art cited and in light of established precedence.

Applicant further argues that Sakurada teaches away from the sucrose esters; however, it is the examiner's position that the teaching of hydrophilic sucrose fatty acid esters does not rise to the level of "teaching away".

Applicant still further argues that Takahashi's listing of potential emulsifiers, including those of the instant invention and those of Sakurada does not show functional equivalence as Takahashi's teaching is limited to the technology of Takahashi and not that of the instant invention; however, it is the examiner's position that no such limitation in technology is established in Takahashi and one of ordinary skill in the art at the time the invention was made would have understood the teaching of Takahashi to be that the emulsifiers were functionally equivalent in emulsifying regardless of the technology used.

Applicant asserts that the declaration filed 31 January and 10 July 2008 shows unexpected results; however, it is the examiner's position that such has not been established for the reasons of record.

### ***Claim Rejections - 35 USC § 103***

6. Claims 1-4 stand rejected under 35 USC § 103(a) as being unpatentable over US Patent 6,193,986 (Sakurada hereinafter) in view of US Patent 4,379,755 (Yamada hereinafter) and in further view of International Patent Application Publication WO

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01/58279 (Takahashi hereinafter). US Patent Application Publication 2003/0035859 is the US equivalent to Takahashi and all references herein are taken therefrom.

Sakurada teaches a foodstuff (Column 1 Lines 5-13) comprising an water-in-oil emulsion (Column 1 Lines 14-33) wherein the oily phase comprises 0.5 to 50% of an emulsifier (Column 6 Lines 16-18)—including hexaglycerol trioleate and sucrose fatty acid esters as exemplified in the instant specification alone or in combination (Column 4 Line 53 – Column 5 Line 31)—and an oily component—including arachidonic acid, eicosapentaenoic acid and docosahexaenoic acid (Column 5 Line 47 – Column 5 Line 15).

Sakurada does not disclose expressly such a composition in an oil-in-water composition.

Yamada discloses an emulsion for use in cosmetics or food wherein the emulsion is of the oil-in-water type (Column 1 Lines 16-60) comprising a sucrose fatty-acid ester emulsifier.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to produce the Sakurada foodstuff as an oil-in-water emulsion as taught by Yamada. The rationale to do so would have been the motivation provided by Yamada that such emulsions are much desired over water-in-oil types as they have superior feel and homogeneity (Yamada Column 1 Lines 37-43 and 67-60).

Neither Sakurada nor Yamada disclose expressly the use of sucrose acetate butyrate as an emulsifying agent.

Takahashi discloses that sucrose acetate isobutyrate is an equivalent emulsifying agent to the sucrose fatty acid esters taught by Sakurada (¶0029).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the sucrose acetate isobutyrate emulsifying agent of Takahashi in the composition of Sakurada. The rationale to do so would have been the teaching of Takahashi that sucrose acetate isobutyrate is a functional equivalent to sucrose fatty acid esters. Further, it has been held that it is *prima facie* obviousness to use a known material based on its suitability for its intended use (*Sinclair & Carroll Co. v. Interchemical Corp.*, 325 US 327, 65 USPQ 297 (1945), *In re Leshin*, 227 F2d 197, 125 USPQ 416 (CCPA 1960) and *Ryco, Inc. v. Ag-Bag Corp.*, 857 F2d 1418, 8 USPQ2d 1323 (Fed Cir 1988)).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached on 6:00 AM - 4:30 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy J. Kugel/  
Patent Examiner, AU 1796

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